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No. 347

In the Supreme Court of the United States

OCTOBER TERM, 1957

EUPHIME V. BERESLAVSKY, PETITIONER

v.

THE UNITED STATES

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

BRIEF FOR THE UNITED STATES IN OPPOSITION

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OPINION BELOW

The opinion of the Court of Claims upholding the validity of petitioner's patent (R. 21-32) is reported at 129 C. Cls. 427. The opinion of the Court of Claims holding that petitioner's patent had not been infringed (R. 51-66) is not yet officially reported.

JURISDICTION

The judgment of the Court of Claims dismissing the complaint was entered on May 8, 1957 (R. 51). The petition for a writ of certiorari was filed on August 6, 1957. The jurisdiction of this Court is invoked under 28 U.S.C. 1255(1).

QUESTIONS PRESENTED

1. Whether petitioner had a valid claim to a patent solely on the basis of his discovery that the substance mesitylene, which is present in almost all gasoline, possessed anti-knock qualities.

2. Whether petitioner's patent, which contemplated the addition to gasoline of the substance mesitylene in the amount of 5 to 20 percent of the total volume of the mixture in order to prevent engine knocking, was infringed by the addition of a compound to aviation gasoline which resulted in the incidental presence in that gasoline of mesitylene in the amount of 0.36 percent of the total volume of the fuel.

STATEMENT

Petitioner in 1929 was issued a patent based upon his discovery that the presence of the substance mesitylene in low compression motor fuel, such as gasoline or kerosene, prevented engine "knocking," *i.e.*, too rapid combustion of fuel in the cylinders of an internal combustion engine, which resulted in the rapid release of energy, usually manifested by an audible knock in the engine (R. 25-26). Petitioner claimed that this patent was infringed in the manufacture of high octane aviation gasoline for the United States during World War II, and brought this suit in the Court of Claims. The Government defended on the grounds both that petitioner's patent was not valid and that in any event it had not been infringed.

The matter was referred to a Commissioner, who, upon joint motion of the parties, was directed to report his recommendations for conclusions of law as well as findings of fact (R. 9). In his first report (R. 9-32), the Commissioner found it unnecessary to pass upon the issue of infringement, concluding instead

from the stipulated facts that petitioner's claim of a patent for the anti-knock substance upon which his infringement suit was based was invalid in view of the prior art (R. 10-13).

Claim 1 of petitioner's patent, the only claim in suit, is as follows (R. 15):

> 1. A low compression motor fuel, such as gasoline or kerosene, containing a compound belonging to the mesitylene group.[1]

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[1] The specification of the patent provides in its entirety as follows (R. 14-15):

> This invention relates to the suppression of a fuel knock in a motor when a mixture of a low compression fuel, such as gasoline or kerosene, and air is burned under a relatively high compression.
>
> I have found that compounds of the mesitylene group, which includes the substance mesitylene, its amino-compounds and derivatives of the amino-compounds, suppress this fuel knock when the fuel mixture is burned in the presence of one of these compounds. These compounds include mesidine, diamino-mesitylene, triamino-mesitylene or their corresponding methyl and ethyl compounds.
>
> In a commercial method of utilizing the invention, one or more of these mesitylenes is admixed with or dissolved in the liquid fuel, alcohol benzol, or some other blending agent, being employed, if desired, to effect a homogeneous admixture.
>
> The same result may be obtained by feeding one of the mesitylenes into the intake of the engine as by atomizing it therein or by feeding it into the combustion chamber of the engine prior to ignition.
>
> By way of example, I may dissolve twenty grams of the diamino-mesitylene in twenty cubic centimeters of ethyl alcohol and mix this solution into one gallon of gasoline. This proportion quantity of anti-knock substance will suppress a knock in present day automobile engines and generally will permit increasing the compression pressure of the engine about twenty pounds.
>
> The effectiveness of the compounds of the mesitylene family as anti-knocks varies, and in general the compounds having the higher specific gravity are more effective quantitatively than the compounds having the lower specific gravity.

The Commissioner found that the claim in suit, on its face, was unambiguous, and referred only to gasoline or kerosene containing mesitylene (R. 11-12), which was a natural constituent of almost all petroleum and gasoline (R. 10).[2] The Commissioner pointed out that, while petitioner had discovered the anti-knock qualities of mesitylene, he was "not the first to discover a composition of matter consisting of gasoline containing mesitylene," and for this reason was not entitled to a patent (R. 11).

Moreover, the Commissioner found that, even if the claim in suit were interpreted in light of its specification to mean gasoline or kerosene with an additive containing mesitylene or its compounds, nevertheless the claim would still be invalid in view of the prior art (R. 12-13). In this connection, he referred to the so-called Taber and Essex patent, issued prior to petitioner's patent and disclosing a motor fuel consisting of gasoline modified by an additive containing, among other compounds, a mesitylene mixture (R. 12). The Commissioner noted that, while the Taber and Essex patent did not specify that the fuel possessed anti-knock qualities, it listed a large number of benefits, all of which are attendant upon and flow from the use of a fuel possessing anti-knock qualities (R. 12). The Commissioner also referred to the question of whether the claim was not fatally defective in that it did not specify to those skilled in the art the proportion of mesitylene to be used, but, in light of his

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[2] Thus the Commissioner found (R. 17) that mesitylene is present in most crude petroleum in amounts ranging from 0.05 to 0.36 percent by volume, and that it is present in the naphtha fraction, which is a close approximation to the gasoline fraction, in a concentration of from 0.22 percent to 1.34 percent by volume.

holding that the claim was invalid in view of the prior art, did not pass upon this question (R. 12-13).

The Court of Claims, while accepting the Commissioner's factual findings, reached the opposite conclusion, holding in its decision of October 5, 1954 (R. 21-32), that the claim in suit was in fact a valid patent. The court held that the claim must of necessity be read in the light of its specification, which it held clearly contemplated the use of mesitylene as an additive to fuel, and as so interpreted constituted a valid patent. The court found that the petitioner's patent was not anticipated by the Taber and Essex patent, since the latter contemplated an additive comprised principally of xylenes, with mesitylene and other benzol derivatives as "also-rans" (R. 23). The court stated (R. 24):

> Since Taber and Essex centered their attention on xylenes, and only mentioned mesitylene incidentally, whereas plaintiff centered his entire attention on mesitylene, it does not seem to us that the Taber and Essex patent anticipated plaintiff's patent.

Finally, the court held that petitioner's claim was not defective because of its failure to specify the proportion of mesitylene to be used, stating that, since different amounts of mesitylene were required to prevent knocking in engines having different compression ratios, "anyone skilled in the art by a little experimentation could readily determine the amount to be added" (R. 25). Accordingly, the court held the patent to be valid and remanded the case to the Commissioner for a determination on the question of infringement (R. 25).

Upon remand, the Commissioner construed the patent, in accordance with the Court of Claims' decision,

as calling for the use of mesitylene as an additive to fuel, but held that the patent as so construed had not been infringed in the manufacture of aviation gasoline for the Government (R. 33-50). The Commissioner found, upon stipulated facts, that the amount of mesitylene contemplated by petitioner as necessary to suppress the knock of a 1923 automobile engine (the type of engine in use at the time petitioner's patent was issued) was between 5 and 20 percent of the fuel by volume, but that the amount of mesitylene present in a typical sample of the accused aviation fuel was approximately 0.36 percent by volume, which was present in a so-called CTC mixture or base used in the manufacture of such gasoline (R. 34-35). The Commissioner held (R. 35):

> It is clear that the mesitylene incidentally present in minor amounts in the accused aviation gasoline is merely an "also ran." The incidental inclusion of small amounts of mesitylene in the CTC distillate was because of its natural presence in the starting materials or because of its formation in the complicated cracking procedures. The incidental mesitylene would have been too expensive to remove. Its effect, if any, was beneficial. Its amount, however, was far too small to produce the result disclosed and intended by the patent in suit.

The Commissioner noted that the amount of mesitylene incidentally included in the Taber and Essex patent referred to above was probably in the range of 2 to 9 percent, and that another prior patent, the Midgley patent, disclosed that anti-knock qualities could be produced in a fuel by blending therewith a benzene ring hydrocarbon, of which mesitylene is one, in

amounts up to 50 percent (R. 35). The Commissioner found further that, in petitioner's application for a British patent corresponding generally to the patent in suit here, he specified and claimed the use of substantially isolated mesitylene or its derivatives to suppress fuel knocking (R. 48).

On the basis of these findings, the Commissioner concluded that "[t]he incidental inclusion of a small mesitylene content of some .36 of one per cent in the accused aviation grade gasoline does not constitute an infringement of the claim in suit when the scope of the claim is necessarily limited by the teachings of the prior art and the patentee himself" (R. 35-36).

The Court of Claims in its opinion dated May 8, 1957 (R. 51-66), adopted the Commissioner's findings and conclusions, stating that it "thoroughly agree[d]" that the presence of mesitylene in the accepted aviation fuel was merely incidental, and that its amount was far too small to produce the result disclosed and intended by petitioner's patent (R. 52). Accordingly, the court dismissed the petition on the ground that petitioner's patent had not been infringed (R. 52).

ARGUMENT

This case presents no issue for this Court's review. In the first place, contrary to the earlier holding of the Court of Claims, it seems plain under settled rules of patent law that petitioner had no valid patent, and accordingly that relief should have been denied him on this ground alone. But even if, as the court held, petitioner's patent was valid, it clearly was not infringed by the production of the aviation gasoline in question. The decision of the Court of Claims to this effect rests upon demonstrably correct inferences

compelled by the stipulated facts of this particular case. It raises no issue of law, general or specific, warranting review here.[3]

1. Petitioner does not have a valid patent. His claim, unambiguous on its face, was simply for "[a] low compression motor fuel, such as gasoline or kerosene, containing a compound belonging to the mesitylene group." As the Commissioner pointed out (R. 10-11), mesitylene and its compounds are natural constituents of most petroleums, and by virtue of their boiling points are also present in the distillates sold commercially as gasoline or kerosene. The discovery that this compound, already present in the fuel, possesses anti-knock qualities does not constitute a patentable invention; "[n]o discovery will entitle the discoverer to a patent which does not in effect amount to the contrivance or production of something which did not exist before * * *." 1 Walker, *Patents* (1937 ed.), p. 36.

Moreover, even if petitioner's claim is interpreted in light of its specification to contemplate the use of mesitylene as an additive to fuel (but see, *e.g.*, *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 277, holding that a specification may not be so used to save an unambiguous claim which on its face is invalid), petitioner was still not entitled to a patent. In the first place, neither the claim nor

[3] This Court has said that, in the absence of a conflict in decisions, it will not grant certiorari in "an ordinary patent case" that does not involve "an important issue of general patent law * * *." *Keller* v. *Adams-Campbell Co.*, 264 U.S. 314, 319; *Layne & Bowler Corp.* v. *Western Well Works*, 261 U.S. 387, 393; see *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 178-179.

the specification is sufficiently definite as to the quantity of mesitylene that must be added to the fuel. For such a patent to be valid, the proportions of the mixture must "be stated with clearness and precision, and not leave a person attempting to use the discovery to find it out by experiment * * *." *Libbey-Owens-Ford Glass Co.* v. *Celanese Corporation,* 135 F. 2d 138, 145 (C.A. 6).[4] Nor can petitioner avoid the consequences of his vagueness by claiming that his patent should be read as contemplating the addition of mesitylene in "sufficient quantity to suppress knock in the engine;" contrary to the decision below, such a claim would be void as dependent for its novelty solely on function. *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U.S. 1, 8; *Purdue Research Foundation* v. *Watson,* 214 F. 2d 221 (C.A.D.C.); *Hall Laboratories* v. *Economics Laboratory,* 169 F. 2d 65 (C.A. 8); *B. B. Chemical Co.* v. *Cataract Chemical Co.,* 122 F. 2d 526, 530 (C.A. 2).

Finally, whatever the technical sufficiency of petitioner's claim, it must be held invalid in view of the prior art. As the Court of Claims found, the prior Taber and Essex patent discloses "a motor fuel consisting of gasoline modified by adding a mesitylene containing mixture thereto," (R. 31), and lists numerous benefits to be derived from this fuel, all of which are "concomitant with decreased engine knock"

[4] This Court has consistently held that, where a new invention is a combination of old ingredients (here, well known chemical compounds), "it is of the greatest importance that the description of the combination, which is the invention, should be full, clear, concise, and exact." *Gill* v. *Wells,* 22 Wall. 1, 25-26, quoted in *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U.S. 1, 10-11. See also *General Electric Company* v. *Wabash Appliance Corporation,* 304 U.S. 364, 369.

(R. 32). This invention plainly anticipated petitioner's claim, which, even read in light of its specification, simply contemplates the mixing with gasoline of a mesitylene additive in an indeterminate amount in order to produce substantially the same benefits enumerated in the Taber and Essex patent.

2. Even if petitioner held a valid patent for a mesitylene additive, the stipulated facts conclusively establish that this patent was not infringed. If valid at all, petitioner's patent obviously must be narrowly construed in terms of the prior art.[5] Only on this basis was the court below able to sustain the validity of the claim, holding that it was distinguishable from the prior Taber and Essex patent because petitioner's additive consisted solely of mesitylene or one of its compounds; in the Taber and Essex additive, mesitylene was present, but merely as an "also-ran" (R. 23-24). Moreover, the court sustained the patent, despite the Government's attack on its failure to specify the proportion of additive to be used, by interpreting the claim to contemplate the addition of sufficient mesitylene to suppress a knock in a 1925 engine (R. 25), which petitioner himself testified to be from 5 to 20 percent of the total amount of the fuel by volume (R. 52, 66).

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[5] A previous determination that a patent is valid does not, of course, preclude utilization of the state of the prior art to construe and narrow its scope in determining the issue of infringement. See *Westinghouse Electric & Manufacturing Company* v. *Formica Insulation Company*, 266 U.S. 342, 351. In the instant case, the prior art, as shown by the Taber and Essex patent and the Midgley patent, demonstrates that petitioner's patent is in no sense a pioneer, and accordingly must be narrowly construed. See, *e.g.*, *Bocjl Corporation* v. *United States*, 120 C. Cls. 347, 394; *Clifford C. Jones* v. *United States*, 120 C. Cls. 747, 799.

In the accused aviation fuel, however, mesitylene was present, not as a deliberately added anti-knock agent in the concentration contemplated by petitioner, but merely as an incidental constituent of the CTC distillate in the minute amount of 0.36 percent by volume of the aviation gasoline. The presence of mesitylene in the aviation fuel was "merely incidental" (R. 52); it was present in the CTC distillate because of its natural presence in the starting materials or because of its formation in the complicated cracking procedures, and would have been too expensive to remove (R. 35).[6] And, as both the Commissioner and the court below held, its amount "was far too small to produce the result disclosed and intended by the patent in suit" (R. 35, 52).

Thus petitioner's patent, even if valid, was not infringed by the manufacture of aviation gasoline for the United States. The decision below to this effect is clearly correct, and requires no review by this Court.

[6] Indeed, it appears from the stipulated facts that isolated mesitylene, as called for in petitioner's patent, was never at any time used commercially as an anti-knock additive; its manufacture "involved great expense, and was done on a very small scale in order to obtain isolated mesitylene for experiments" (R. 65).

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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